



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,892	01/26/2004	Tsutomu Okada	17376	9699

23389 7590 12/07/2007  
SCULLY SCOTT MURPHY & PRESSER, PC  
400 GARDEN CITY PLAZA  
SUITE 300  
GARDEN CITY, NY 11530

EXAMINER
----------

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
----------	--------------

3739

MAIL DATE	DELIVERY MODE
-----------	---------------

12/07/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/764,892

Applicant(s)

OKADA, TSUTOMU

Examiner

Matthew J. Kasztejna

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/26/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Notice of Amendment*

In response to the amendment filed on October 26, 2007, amended claims 14-15 are acknowledged. The objection to claims 14-15 is *withdrawn*. The following reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-18 are rejected under 35 U.S.C. 103(a) as being anticipated by Nakada et al. (U.S. Patent Application Publication No. 2001/0053909) in view of Suzuki (U.S. Patent No. 6,068,063).

**In regards to claims 2-7 and 11-16**, Nakada et al. teach a diathermic snare used in combination with an endoscope, the endoscope 3 including an inserting section 4 with is inserted into a body cavity and which has a distal end and a proximal end, and a cylindrical cap section 1 mounted on the distal end of the inserting section, the cap section having a distal end, a proximal end and an engagement projection having a bending portion that bends inward at the distal end of the cap section (see Figs. 1 and 3), wherein the diathermic snare comprises: an elongate flexible sheath 9 having a distal end and a proximal end; an operating wire inserted into the sheath so as to move forward and backward and having a distal end and a proximal end; a snare wire 16b

coupled to the distal end of the operating wire and having a loop section which expands like a loop (see Fig. 4); an operating section coupled to the proximal end of the sheath and including a operating section coupled to the proximal end of the sheath and including a guide member extending in an axial direction of the sheath and a slider which moves forward and backward in the axial direction of the sheath along the guide member and which is coupled to the proximal end of the operating wire; the loop section of the snare wire projecting from the distal end of the sheath, the snare wire expanding like a loop, and the loop section expanding along an inner circumference of the engagement projection when the slider moves toward along the guide member (see Figs. 1 and 3-6); wherein the cap section has an inclined plane corresponding to a plane of the cap section which is inclined to the axial direction of the sheath (see Figs 7-8). Nakada et al. are silent with respect to a distal-end bent portion provided at the distal end of the loop section. Suzuki teaches of an analogous medical instrument system using a diathermic snare and an endoscope in combination with each other wherein the snare 16 may be formed of stainless spring steel, a superelasticity alloy wire material such as an Ni--Ti alloy, or a resin such as polyamide, which are elastic sufficient to expand and contract and have a sufficient sharpness as knives. Furthermore, the expansible section 16a of the snare is bent at a predetermined angle with respect to the rear support section (see Figs. 1-2 and Col. 7, Lines 30-53). It would have been obvious to one skilled in the art at the time the invention was made to include a distal-end bent portion provided at the distal end of the loop section in the apparatus

of Nakada et al. to allow for greater efficiency in grasping tissue during surgical procedures as taught by Suzuki.

**In regards to claims 8-10 and 17-18**, Nakada et al. teach a diathermic snare used in combination with an endoscope, wherein cap section has an inclined plane corresponding to a plane of the distal end of the cap section which is inclined to the axial direction of the sheath; and the bending portion of the loop section bends in the axial direction of the sheath (see Figs 7-8 and paragraphs 0056-0059).

### ***Response to Arguments***

Applicant's arguments filed October 26, 2007 have been fully considered but they are not persuasive.

The applicant's arguments with respect to Suzuki's snare loop 16a being prevented from rotating with respect to the sheath 9 when the bent portion of the loop portion of the snare projects from the snare pipe 18 are irrelevant with respect to the recited claims. Suzuki is used merely as a teaching that it is well known in the art to provide a bend at the distal end of a snare loop of varying angles, not as a teaching to rotate the loop section around an axis of the sheath. Nakada et al. teach of a rotatable snare wire 16b that is let out of the sheath 16a while the tip portion of the snare wire 16b is placed on the flange 7, thus allowing the loop of the snare wire 16b to widen along the inner surface at the on the cap part 2 (see Figs. 4 and 7-8 and paragraph 0045 and 0058-0063). Nakada et al. are silent with respect to a distal-end bent portion provided at the distal end of the loop section. However, if the bent portion, as taught by Suzuki (see Figs. 1-2 and Col. 7, Lines 30-53), is provided in the loop section of the

snare wire of Nakada et al., the snare loop would be capable of more securely engaging the flange provided on the distal end of the cap section of Nakada et al. and allow easier deployment and widening of the loop of the snare wire, and ultimately greater efficiency in grasping tissue during surgical procedures. As broadly as claimed, the combination of Suzuki and Nakada et al. meet the limitations of the recited claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

Application/Control Number:  
10/764,892  
Art Unit: 3739

Page 6

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK 

12/04/07

  
LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700